

REMARKS

This Response is submitted in reply to the Office Action mailed June 21, 2005. Applicants have amended Claims 1, 19, 34, and 52. Applicants have amended the Specification to update the cross references to related co-pending commonly owned U.S. patent applications. A Supplemental Information Disclosure Statement and a Petition for a one month extension of time to respond to the Office Action are submitted herewith. A check in the amount of \$300.00 is enclosed to cover the cost of the Supplemental Information Disclosure and the one month extension. Please charge Deposit Account No. 02-1818 for any insufficiency of payment in connection with this Response.

The Office Action rejected Claims 1, 3 to 19, 22 to 34, 37 to 53, and 55 to 67 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,833,537 to Barrie ("*Barrie*") in view of U.S. Patent No. 6,471,208 to Yoseloff et al. ("*Yoseloff*"). Applicants respectfully disagree and traverse these rejections for the reasons discussed below. Nonetheless, Applicants have amended independent Claims 1, 19, 34, and 52 to clarify the meaning of the existing claim elements and not for any reasons of patentability. No new matter is added by these amendments.

Barrie is generally directed to a wagering game including a display device configured to display a first game having a primary set of reels. The reels include a plurality of symbols for playing rounds of the game wherein each of the rounds has an outcome. The display device displays at least one of a plurality of indicators, wherein the display of the indicator persists through at least portions of two or more rounds of the game.

In one embodiment of *Barrie*, the indicators are symbols which persist through successive rounds of a game (i.e., in a reel slot machine game, *Barrie* defines a "round" as pulling the slot machine handle and waiting for the reels to stop spinning (Col 1:34-37)). These persistent symbols can result in enhanced payout amounts. For example, in one embodiment of *Barrie*, payline multipliers are used as persistent symbols, wherein the multipliers are applied to the prize amounts, if any, awarded on the primary set of reels (Fig. 4).

In one embodiment of *Barrie*, a persistent symbol is provided in response to an event, such as a designated gaming symbol appearing in a particular position after a spin of the reels (Col 3: 46-51). In this embodiment, the persistent symbol occupies the same position as the gaming symbol which triggers its appearance. Once positioned, the persistent symbol will persist, at least through one, and potentially through several successive rounds of the game, even though the gaming symbol occupying that position in subsequent spins will change (Col 3: 60-67). For example, in the embodiment of Fig. 1, when a spin of the reels results in the appearance of a red ball (one of the gaming symbols on the reels) in a certain position, a ring appears on the same position as the red ball. Upon reactivation of the reels, the ring remains on the position where the red ball symbol was located, although a new gaming symbol on the reels will likely take the place of the red ball.

Although persistent symbols can last through multiple rounds or spins, *Barrie* discloses a mechanism for removing persistent symbols. In one embodiment, persistent symbols can be deleted when another designated symbol lands in a position bearing the persistent symbol. The appearance of the designated symbol causes the persistent symbol to be removed from its position for the subsequent round of the game. For instance, another gaming symbol on the reels, such as a black ball, is defined such that if the black ball lands in a position bearing the ring (the persistent symbol), the ring is removed from that position (Fig. 1).

An objective of *Barrie* is to provide a game which encourages players to play multiple rounds of the game, thereby increasing device use and revenues to the casino or game operator (Col. 1:45-50). Unlike previous gaming environments, in which symbols displayed in a game are always independent of one another, *Barrie* provides a gaming device wherein the reward-affecting symbols do not always change from one round to the next to motivate players to continue playing successive rounds of the game (Col. 1:50-67 and Col. 2:1-4). The players, however, make an additional wager each time they elect to reactivate the reels to play another round of the game (Fig. 3). When players are faced with the choice of whether or not to reactivate the reels, placing another wager seems especially worthwhile because the persistent symbols can impact the amount of the payout in subsequent spins (or rounds).

Yoseloff generally discloses a wagering game including a first game having a number of reels, each of the reels having a number of symbols. When a player spins the reels and a combination of symbols predetermined to be a defining event appears on the reels, the player advances to a bonus game. A preferred feature of the bonus game is the inclusion of symbols that serve special functions. One such special symbol entitles a player to a free spin of the reels (Col 10:18-23).

Amended independent Claim 1 is directed to a gaming device including a plurality of sections, an outcome associated with the sections, a plurality of reels, and a plurality of symbols on the reels. The symbols include a plurality of different section indicator symbols, each of the section indicator symbols associated with one of the sections. The gaming device of Claim 1 further includes a modifier associated with the section indicator symbols. Upon a triggering event associated with the section indicator symbols, a processor provides a plurality of free spins to the player and activates the reels for each of the provided free spins. The processor is further operable to obtain at least one of the sections when a designated combination of the section indicator symbols associated with the section occurs on the reels, increment the modifier when the designated combination of the section indicator symbols occurs on the reels, and provide the outcome to the player when each of the sections has been obtained, wherein the outcome is modified by the modifier.

To the reject Claim 1, the Office Action asserts that it would have been obvious for one of ordinary skill in the art at the time of invention to have combined the use of a multiplier with a section game outcome. Although *Barrie* discloses a multiplier for the multiplication of prize amounts awarded on the primary set of reels, the Office Action admits that *Barrie* is silent regarding the application of a multiplier on a section game outcome and the inclusion of free spins. (Office Action, page 3). Similarly, *Yoseloff* does not include the element of a modifier applied to a section game outcome. Accordingly, Applicants respectfully submit that *Barrie* and *Yoseloff*, either individually or in combination, do not teach, disclose, or suggest the application of a modifier to a section game outcome. Moreover, the Office Action does not offer any explanation as to why a person of ordinary skill in the art would be motivated to modify the prior art references in this manner.

The Patent Office must show the “reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art” and combine those elements in the same manner as the claimed invention. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). These “reasons” need to be specific reasons, not general overarching reasons for combining two references or groups of references. Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. See *B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F. 3d 1577, 1582 (Fed. Cir. 1996). Therefore, it is well established that a specific motivation must be identified in the prior art to establish that there is adequate teaching or suggestion to modify the cited reference to make the present invention.

In this case, the Office Action fails to provide the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of the presently claimed invention to combine the use of a multiplier with a section game outcome in the manner disclosed in Claim 1. Thus, Applicants respectfully submit that the Office Action’s statement concerning the prior art references and the knowledge of one skilled in the art is legally insufficient as a basis for an obviousness rejection.

The Office Action further proposes that modifying the gaming device of *Barrie* to include the free spins of *Yoseloff* would have been obvious to one of ordinary skill in the art at the time of invention in order to provide an alternative payout means that serves to increase device use. (Office Action, page 4). As discussed above, neither *Barrie* nor *Yoseloff* teach, disclose, or suggest the application of a modifier on a section game outcome, as disclosed in Claim 1. Accordingly, incorporating the free spins of *Yoseloff* into *Barrie* does not remedy the deficiencies of *Barrie*. Additionally, Applicants respectfully submit that the Office Action improperly uses hindsight reasoning by combining two references that render the primary reference unsatisfactory for its intended purpose.

Obviousness cannot be based on the hindsight combination of components selectively culled from prior art to fit the parameters of the claimed invention. See *ATD*

Corp. v. Lydall, 48 U.S.P.Q.2d 1321, 1329 (Fed. Cir. 1998). The best argument against "hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine [the] prior art references." *Sensonics, Inc. v. Aerosonic Corp.*, 38 U.S.P.Q.2d 1551, 1554 (Fed. Cir. 1996). "If [a] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984).

As discussed above, the gaming device of Claim 1 includes providing a plurality of free spins to a player and activating the reels for each provided free spin. As the name suggests, the spins provided to the player are free; therefore, the player may continue to activate the reels at no cost until there are no free spins remaining. Incorporating the free spins of *Yoseloff* into the game of *Barrie* renders *Barrie* unsatisfactory for its intended purpose of enticing a player to make an additional wager to play another round of the game (i.e., to reactivate the reels). Thus, one of ordinary skill in the art would not be motivated to combine the free spins of *Yoseloff* into *Barrie* to achieve the gaming device disclosed in Claim 1.

For at least the reasons discussed above, Applicants respectfully submit that combining *Barrie* with *Yoseloff* in the manner referred to in the Office Action is an improper basis for the rejection of Claim 1. Accordingly, amended Claim 1 and the claims which depend therefrom are in condition for allowance, and the rejections should be withdrawn.

Independent amended Claim 19 includes certain similar elements to Claim 1. Claim 19 is directed to a gaming device including, among other elements, a plurality of sections, a plurality of reels, and a plurality of symbols on the reels. Applicants have amended Claim 19 to clarify that a plurality of free spins are provided to the player, and the reels are activated for each of the provided free spins. As discussed above, incorporating the free spins of *Yoseloff* into the game of *Barrie* renders *Barrie* inoperable for its intended purpose. Thus, one of ordinary skill in the art would not be motivated to combine *Barrie* with *Yoseloff* to achieve the gaming device disclosed in Claim 19. For at least this reason, Applicants respectfully submit that Claim 19 and the

claims which depend therefrom are in condition for allowance, and the rejections based on the combination of *Barrie* with *Yoseloff* should be withdrawn.

Amended independent Claim 34 is directed to a gaming device which includes, among other elements, a plurality of symbols on reels, wherein the symbols include a plurality of different section indicator symbols. Each of the section indicator symbols is associated with one of a plurality of sections. The gaming device includes a processor operable to provide a player with a plurality of free spins of the reels upon the occurrence of a triggering event, activate the reels for each of the provided free spins, and obtain at least one of the sections when a designated combination of the section indicator symbols occurs on the reels. The processor is further operable to eliminate the section indicator symbol associated with the obtained section from the reels when the designated combination of section indicator symbols occurs on the reels. When each of the sections is obtained, the processor provides an outcome associated with the sections to the player.

Unlike the gaming device of Claim 34, neither *Barrie* nor *Yoseloff* discloses eliminating section indicator symbols from the reels. As described above, one embodiment of *Barrie* states that the appearance of a designated gaming symbol in a certain position on the primary reels triggers the initial appearance of a persistent symbol (Fig. 1). The persistent symbol occupies the same position as the triggering gaming symbol until another designated gaming symbol appears in that position to cause its removal. In *Barrie*, only the persistent symbol is eliminated upon the appearance of a designated gaming symbol on the reels—not the gaming symbol which triggers its appearance or disappearance. Accordingly, in the gaming device resulting from the combination of *Barrie* and *Yoseloff*, the gaming symbols which trigger the appearance or disappearance of the persistent symbols are not removed from the reels. On the other hand, the gaming device of Claim 34 removes the actual section indicator symbols corresponding to the obtained sections from the reels.

It should be appreciated that eliminating the section indicator symbols from the reels plays an entirely different role in the gaming device of Claim 34 than that of removing the persistent symbols in *Barrie*. The effect of eliminating the section indicator symbols in Claim 34 is that only the symbols associated with sections that have not

been obtained in the game remain on the reels. Thus, the player's chance of subsequently obtaining a designated combination of symbols required to remove a different section is enhanced because there are fewer symbols on the reels.

To further support the rejection of Claim 34, the Office Action relies on an embodiment of *Barrie* used in connection with an electronic keno game. Specifically, the Office Action refers to a paragraph in the *Barrie* specification which states that the number of deleted persistent symbols in this embodiment may vary from round to round. Preferably, the number deleted is, at least on average, low enough to permit a determined player to eventually win the prize, but large enough to require players in most cases, to play a large number of rounds in order to have a reasonable chance of winning the prize (Col 6: 34-47). This statement confirms that deleting the persistent symbols in *Barrie* has a negative impact on the player's chance of winning. Accordingly, in the gaming device resulting from the combination of *Barrie* and *Yoseloff*, eliminating the persistent symbols diminishes some, if not all, of the progress that a player has made in previous rounds of the game. On the other hand, eliminating section indicator symbols in Claim 34 increases the player's chance of revealing the outcome as the game progresses and more symbols are eliminated from the reels.

The Office Action fails to appreciate the distinction between the section indicator symbols in Claim 34 and the persistent symbols in *Barrie*. *Barrie* does not teach, disclose, or suggest the elimination of section indicator symbols from the reels, nor does combining *Barrie* with *Yoseloff* remedy this deficiency of *Barrie*. Accordingly, for these reasons and the reasons discussed above with respect to Claim 1, Applicants respectfully submit that amended Claim 34 and the claims which depend therefrom are each in condition for allowance.

Independent amended Claim 52 includes certain similar elements to Claim 34. Claim 52 includes, in combination with other elements, the step of eliminating the section indicator symbol from the reels when a designated symbol combination is indicated on the reels. For at least the reasons discussed above with respect to Claim 34, Applicants submit that amended independent Claim 52 and the claims which depend therefrom are each in condition for allowance, and the rejections based on the combination of *Barrie* with *Yoseloff* should be withdrawn.

been obtained in the game remain on the reels. Thus, the player's chance of subsequently obtaining a designated combination of symbols required to remove a different section is enhanced because there are fewer symbols on the reels.

To further support the rejection of Claim 34, the Office Action relies on an embodiment of *Barrie* used in connection with an electronic keno game. Specifically, the Office Action refers to a paragraph in the *Barrie* specification which states that the number of deleted persistent symbols in this embodiment may vary from round to round. Preferably, the number deleted is, at least on average, low enough to permit a determined player to eventually win the prize, but large enough to require players in most cases, to play a large number of rounds in order to have a reasonable chance of winning the prize (Col 6: 34-47). This statement confirms that deleting the persistent symbols in *Barrie* has a negative impact on the player's chance of winning. Accordingly, in the gaming device resulting from the combination of *Barrie* and *Yoseloff*, eliminating the persistent symbols diminishes some, if not all, of the progress that a player has made in previous rounds of the game. On the other hand, eliminating section indicator symbols in Claim 34 increases the player's chance of revealing the outcome as the game progresses and more symbols are eliminated from the reels.

The Office Action fails to appreciate the distinction between the section indicator symbols in Claim 34 and the persistent symbols in *Barrie*. *Barrie* does not teach, disclose, or suggest the elimination of section indicator symbols from the reels, nor does combining *Barrie* with *Yoseloff* remedy this deficiency of *Barrie*. Accordingly, for these reasons and the reasons discussed above with respect to Claim 1, Applicants respectfully submit that amended Claim 34 and the claims which depend therefrom are each in condition for allowance.

Independent amended Claim 52 includes certain similar elements to Claim 34. Claim 52 includes, in combination with other elements, the step of eliminating the section indicator symbol from the reels when a designated symbol combination is indicated on the reels. For at least the reasons discussed above with respect to Claim 34, Applicants submit that amended independent Claim 52 and the claims which depend therefrom are each in condition for allowance, and the rejections based on the combination of *Barrie* with *Yoseloff* should be withdrawn.

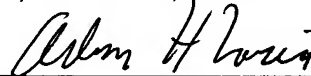
The Office Action rejected Claims 2, 3, 20, 21, 35, 36, and 54 under 35 U.S.C. 103(a) as being unpatentable over *Barrie* in view of *Yoseloff*, in further view of U.S. Patent No. 5,449,173 to Thomas ("*Thomas*"). The Office Action cites *Thomas* for including the use of a "wild symbol." The Office Action states that it would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate the use of wild symbols, as disclosed by *Thomas*, into the gaming device of *Barrie* in order to forward game play.

Applicant respectfully submits that, regardless of whether it would have been obvious to include wild symbols in the gaming device of *Barrie* to forward game play, the gaming device resulting from the combination of *Barrie* and *Thomas* does not achieve the gaming device disclosed in Claims 2, 3, 20, 21, 35, 36, and 54. Similarly, incorporating the wild symbols of *Thomas* into the gaming device resulting from the combination of *Barrie* and *Yoseloff* does not cure the deficiencies of *Barrie* and *Yoseloff* described above with respect to Claims 1, 19, 34, and 52. Accordingly, for at least the reasons provided above with respect to independent Claims 1, 19, 34, and 52, Applicants respectfully submit that Claims 2, 3, 20, 21, 35, 36, and 54 are patentably distinguished over the combination of *Barrie*, *Yoseloff*, and *Thomas* and are in condition for allowance.

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding this Response, Applicant respectfully requests that the Examiner contact the undersigned.

Respectfully submitted,

BELL, BOYD & LLOYD LLC

BY 

Adam H. Masia
Reg. No. 35,602
Customer No. 29159

Dated: October 14, 2005